

REMARKS

Reconsideration of this Application is respectfully requested. Claims 10-32 are currently pending, with claims 10, 21 and 26 being the independent claims. Claims 10, 21 and 26 are amended herein. New claims 27-32 have been added. The Applicant respectfully submits that these amendments and new claims introduce no new matter. Based on the above Amendments and the following Remarks, the Applicant respectfully requests that the Examiner reconsider and withdraw all outstanding rejections.

Interview Summary

The undersigned appreciates the time and attention extended by Examiner Snow during the interview conducted on May 1, 2006. During the interview, the Examiner agreed to withdraw the rejection under 35 U.S.C. § 112. The independent claims were discussed with respect to U.S. Patent No. 5,599,291 to Balbierz et al. ("*Balbierz*") and U.S. Patent No. 4,874,360 to Goldberg et al. ("*Goldberg*"). The Applicant proposed amending claims 10, 21 and 26 to clarify that the third section of the stent body comprises a co-extrusion of the first and second materials. The Examiner agreed that the proposed amendment appeared to distinguish over *Goldberg*, but indicated that a further search may be required.

Rejections under Nonstatutory Obvious-Type Double Patenting

Claims 10-26 were rejected on the ground of nonstatutory obvious-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,620,202 to Bottcher et al. and claims 1-9 of U.S. Patent No. 6,719,804 to St. Pierre. The Assignee submits herewith terminal disclaimers in compliance with 37 CFR § 1.321(b). Accordingly, the Applicant requests that the nonstatutory obvious-type double patenting rejection be withdrawn.

Rejections Under 35 U.S.C. § 112

Claims 10-26 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and claim the subject matter which the applicant regards as the invention. During the interview, the Examiner agreed that the claim language “irregular configuration” is adequately defined and supported in the specification and that the rejection under § 112 will be withdrawn. Accordingly, the Applicant requests that the rejection of claims 10-26 under 35 U.S.C. § 112 be withdrawn.

The Claims are Allowable over U.S. Patent No. 5,599,291 to Balbierz

Claims 10-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Balbierz*. *Balbierz* discloses a polymeric ureteral stent capable of concurrent softening and expanding when placed into a patient’s body. More particularly, *Balbierz* discloses a stent constructed of two different polymers, a hydrophilic polymer, which softens and expands when exposed to a bodily fluid, and a non-hydrophilic polymer. *See e.g.*, Column 3, Lines 16-19. As discussed during the interview, however, *Balbierz* fails to disclose or suggest a ureteral stent having a “third section . . . located between the first

and section sections, wherein the third section comprises a co-extrusion of the first and second materials and wherein the first and second materials are distinct and in an irregular configuration,” as recited in independent claims 10, 21 and 26. Rather, *Balbierz* discloses that either the proximal (124) or the distal (120) retention means can include “more hydrophilic component on one side . . . than on the other side.” Column 12, Lines 53-56. *Balbierz* discloses that this asymmetrical arrangement causes the proximal or distal end portion “to curl and form the proximal retention means and/or the distal retention means . . .” Column 12, Lines 62-64. In fact, *Balbierz* does not disclose or suggest an asymmetrical arrangement in the body portion (118), because such an arrangement would result in an undesirable curling of the body portion (i.e., the third portion), which is configured to be disposed in the ureter of a patient, thereby destroying the functionality of the stent.

Accordingly, the Applicant respectfully submits that, for at least this reason, independent claims 10, 21 and 26, and their respective dependent claims, are patentably distinct from *Balbierz*.

The Claims are Allowable over U.S. Patent No. 4,874,360 to Goldberg

Claims 10 and 12-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Goldberg*. Additionally, claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Goldberg*. *Goldberg* discloses ureteral stent having “a proximal hook portion (13) made of a homogenous, thermoplastic material which is substantially stiffer than the soft, more flexible material from which the remainder of the stent is formed.” Column 4, Lines 2-6. More particularly, *Goldberg* discloses that the proximal hook portion is joined to the remainder of the stent by a polyurethane material (22), which is

disposed between the two portions. Column 3, Lines 18-28. As discussed during the interview, however, Goldberg fails to disclose or suggest a ureteral stent having a “third section . . . wherein the third section comprises a co-extrusion of the first and second materials . . .” as recited in independent claims 10, 21 and 26.

Accordingly, as discussed during the interview, the Applicant respectfully submits that, for at least this reason, independent claims 10, 21 and 26, and their respective dependent claims, are patentably distinct from *Goldberg*.

New Claims 27-32 are Allowable

New claims 27-32 are allowable over both *Balbierz* and *Goldberg* for at least because they depend from independent claim 10 or independent claim 21, both of which are allowable as discussed above.

Conclusion

All of the stated grounds of rejection and objection have been properly traversed or rendered moot. The Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections and objections. The Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this application is respectfully requested.

The Director is hereby authorized to charge any appropriate fees under 37

C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any
overpayment, to Deposit Account No. 50-1283.

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